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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,221	08/13/2001	Stephen F. Gass	SDT 302	2131

27630 7590 07/23/2004

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EXAMINER
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ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,221

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9, 10, 12-14, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 10, 12-14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/25/04, 4/17/04
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: 1449's - 3/7/04 & 2/9/04

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## DETAILED ACTION

1. This office action is in response to applicant's after final filed 4/25/04, wherein claims 8, 11, 15, 18 were amended; and claims 7-8, 11, 15 and 18 were canceled.

### ***Response to Amendment***

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The comments regarding the withdrawal of finality of the previous office action are noted. The previous office action is henceforth withdrawn in view of the following rejection. The instant office action is final based upon the current amendment.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 09/929,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim

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terminology used but encompass the same subject matter, for example, application '426 includes claims directed to a woodworking tool having a cutting tool that is capacitively coupled to a contact detection system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/146,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, for example, application '527 includes claims directed to a woodworking tool having a cutting tool mounted on a shaft, wherein the cutting tool is capacitively coupled to a contact detection system through said shaft.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/215,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, for example, application '929 includes claims directed to a woodworking tool having a cutting tool that is capacitively coupled to a contact detection system.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5-6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hornung et al., U.S. Patent 4,722,021, as set forth in paragraph 14 of paper number 12.

9. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Friemann et al., U.S. Patent 3,858,095, as set forth in paragraph 15 of paper number 12.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 12-14 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by Hornung or, in the alternative, under 103(a) as being unpatentable over Hornung as set forth in paragraph 16 of paper number 12.

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12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hornung in view of Hathaway, U.S. patent 5,587,618, as set forth in paragraph 17 of paper number 12.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hornung in view of Hathaway and Morrow as set forth in paragraph 18 of paper number 12.

### ***Response to Arguments***

14. Applicant's arguments filed 4/25/04 have been fully considered but they are not persuasive.

Applicant contends that Hornung is different from claim 1 of the instant application because claim 1 requires one or more drive electrodes that form a capacitive coupling with the shaft on which the cutting tool is mounted while Hornung discloses "a capacitor 9 that is connected by a wire or other conductor to a bearing 7 that supports a spindle 8. There is no electrode in Hornung that forms a capacitive coupling with a shaft". However, the examiner respectfully disagrees. Hornung does not disclose any such wire for connecting to the bearing; however, column 3, lines 25-35 discloses that the capacitor 9 has electrodes. Moreover, it should be noted that all capacitors have "electrodes" and even if it is argued that all capacitors don't have electrodes one of ordinary skill would readily recognize the electrical connections of the capacitor as "electrodes" because the term "electrodes" is defined as "a solid electric conductor through which an electric current enters or leaves a medium or a collector/emitter of electric charge". Clearly, the connections of capacitor are electrodes.

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Applicant further contends that Hornung lacks a capacitive coupling where one of the conductors is part of the shaft or coupled to and moving with the shaft and where the other conductor is a drive electrode. However, the examiner respectfully disagrees. Claim 1 only requires that a conductor be coupled to the shaft such that it rotates with the shaft and where another conductor is the drive electrode. Hornung et al. discloses a conductor, e.g., the bearings which rotate when the shaft rotates and transmit the signal from the capacitor, e.g. drive electrode, to the blade.

Applicant further contends that Hornung lacks a contact detection system for detecting contact between a person and the cutting tool. Although, it is true that Hornung does not specifically state that the contact detection system detects human contact it should be noted that it is fully capable of detecting human contact as explained previously.

Applicant contends that Friemann et al. lacks the conductive coupling between the contact detection system and the cutting tool. However, the examiner respectfully disagrees for the reason set forth in the previous office action and further reiterated here. Although, it is true that the bridge circuit in Friemann is conductively coupled between the oscillator and the amplifier, wherein the capacitance of the cutting is part of the bridge circuit it should be noted that claim 17 merely recites "a capacitive coupling between the contact detection system and the cutting tool" and the intended use "where the contact detection system is configured to impart an electrical signal onto the cutting tool through the capacitive coupling". In this case, just because the cutting tool is described as part of the capacitive coupling does not mean that there is no electrical

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signal imparted to the tool by the coupling. The contact detection system of Friemann et al. creates capacitive coupling which includes the cutting tool wherein a electrical signal is created by the capacitive coupling.

Applicant contends that Hornung fails to show or suggest a cutting and supported by and insulated from the frame; however, the examiner respectfully disagrees. Hornung discloses that the blade has a signal transmitted to it through the bearings supporting the shaft of the blade. Therefore, the signal is transmitted from the capacitor to the bearings to the shaft to the blade. The blade, shaft and bearings must be insulated from the frame of the device or it cannot work because Hornung contact system requires a grounded connection with the blade to detect a dangerous condition. If the frame was not insulated then the frame would interfere with the functioning of the device.

15. For the reasons above, the grounds of rejection are deemed proper.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the




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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
July 20, 2004